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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,742	12/20/2001	Sameer D. Mehta	88-1061A	3797

7590 01/13/2004

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EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	//

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/027,742	Applicant(s) MEHTA ET AL.
	Examiner Rip A. Lee	Art Unit 1713

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ they raise the issue of new matter (see Note below);
   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____.
3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *1,3-9 and 14-20*.

   Claim(s) objected to: _____.

   Claim(s) rejected: *10-12*.

   Claim(s) withdrawn from consideration: _____.
8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☒ Other: *attachment to advisory action*

Attachment to Advisory Action

This advisory action follows an after-final response filed on November 10, 2003. Applicants present proposed amended claim 10 for reconsideration. Claim 13 was canceled.

The proposed amendment is insufficient to overcome the rejection of claims under 35 U.S.C. 102(b)/103(a) in view of U.S. Patent No. 5,717,000 to Karande *et al.*, set forth in previous office actions.

To recapitulate, the prior art teaches a process for making a composition by dispersing organophilic particles into a melt comprising an olefinic polymer having polar functionality (claim 1). The organophilic material is montmorillonite intercalated with dimethyl dehydrogenated tallow ammonium ions (claim 5), and the polymer is ethylene-vinyl acetate (claim 13). Examples are Escorenes which contain about 6-18 wt % of vinyl acetate units. The compositions shown in the examples contain about 4.5 wt % of clay material. Contrary to Applicants' viewpoint, the *composition* is disclosed fully in the prior art. According to the parent claim of Karande *et al.*, no other ingredients which would *materially* affect the basic and novel characteristics of the claimed invention.[†] The blowing agent is inert, and liberates N_2 and CO_2 to expand the polymer. Therefore, the composition would not be materially affected.

Applicants note that the prior art is completely silent with respect to melt index and complex viscosity of the product described therein. This fact was also acknowledged in previous office actions.

[†] *In re Herz* 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976); see also MPEP § 2111.03.

It must be appreciated that the prior art does not recite a rheological measurement (*i.e.*, a physical property). This is completely different from a situation where the prior art does not recite one of the claimed *components* (in which case, a rejection under 35 U.S.C. 102 would be invalid). It is well accepted that products of identical chemical composition can not have mutually exclusive properties. In such instances, where the examiner provides rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, the burden of proof may be shifted to Applicants to come forward with evidence establishing an unobviousness difference between the claimed product and the prior art.‡

Karande *et al.* was shown to disclose the claimed composition (*vide supra*), and consequently, the Applicants were requested to establish an unobviousness difference regarding the rheological parameters.

Applicants inquire rhetorically, "how can a foamed material which has cellular structure...have a melt index remotely similar to that specified for Applicant's composites." Regardless of form (sheet, web, foam, film, pellet), the material would exhibit the same melt index if it were made of the same material of the present invention. Merely stating that "melt index measurements are typically not performed with foams and may not even be possible" is insufficient in meeting a burden of proof for establishing any unobviousness differences.

In view of this and previous discussions, the rejection of claims 10-12 in view of Karande *et al.* has not been withdrawn.

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‡ *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claims 1, 3-9, and 14-20 remain allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-1104.

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January 5, 2004

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